

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	§	Group Art Unit: 2141
Bernard A. Traversat, et al.	§	
	§	Examiner: Luu, Le Hien
Serial No. 10/055,645	§	
	§	Atty. Dkt. No.: 5181-82104
Filed: January 22, 2002	§	
	§	
For: PEER-TO-PEER	§	
NETWORK COMPUTING	§	
PLATFORM	§	

REQUEST FOR REHEARING UNDER 37 C.F.R. § 41.52

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir/Madam:

In response to the Decision on Appeal rendered February 2, 2011 (hereinafter Decision), Appellants present this Request for Rehearing under 37 C.F.R. § 41.52. Appellants respectfully request that the Board of Patent Appeals and Interferences consider this request in view of the following remarks.

INTRODUCTION

Appellants' claim 1 is directed to a peer computing system that includes peer protocols through which peers may discover each other and cooperate with each other to form peer groups. Appeal Brief at page 6. The peer computing system includes a plurality of peer nodes. *Id.* At least a subset of the peer nodes in the peer computing system are configured to participate in a peer discovery protocol to discover other peer nodes. *Id.* At least a subset of the peer nodes in the peer computing system are configured to participate in a peer membership protocol for joining or forming a peer group with other peer nodes. *Id.*

In its decision, the Board finds that Teodosiu et al. (U.S. Publication 2002/0062375) "qualifies as prior art with respect to Appellants' claimed invention." Decision at 6-7. However, the Board's finding is contrary to Federal Circuit precedent in that it has not been established that every portion of Teodosiu's published application relied upon to reject Appellants' claims are found in one of Teodosiu's provisional applications. See the recent case of *In re Giacomini*, 2010 WL 2674461 (Fed. Cir. 2010), in which in regard to the use of a provisional application to establish a prior art date, the Federal Circuit stated: "An important limitation is that the provisional application must provide written description support for the claimed invention." The Board's findings fail to adequately demonstrate that Teodosiu's provisional application provides written description support for the claimed invention.

The Board's findings also fail to establish the additional requirement of Teodosiu's provisional application satisfying the written description requirement for at least one claim found in Teodosiu's published application.

The Board's findings are also counter to a previous Board Decision in a case similar to the present application considering the same Teodosiu reference.

In addition, the Board affirms the rejection of claim 1 as being unpatentable over Teodosiu and Badovinatz et al. (U.S. Patent 5,896,503) (hereinafter “Badovinatz”) under 35 U.S.C. § 103(a). Decision at 7-9. However, the Board misapprehends the Teodosiu reference’s teachings and overlooks the entirety of Appellants’ actual argument as stated at pages 16-18 in the Appeal Brief and pages 7-8 of the Reply Brief in finding that Teodosiu meets the claims limitation *wherein at least a subset of the peer nodes are configured to participate in a peer discovery protocol to discover other peer nodes*.

Accordingly, as established below, Appellants submit that the Board’s decision is contrary to both the facts of this case and relevant law.

ARGUMENT

Appellants respectfully submit that the Board's decision misapprehends or overlooks the following points.

1. The Board, in the Decision, misapprehends or overlooks facts regarding the issue of whether subject matter as used from Teodosiu 2002/0062375 (the cited reference) in the rejection of Appellants' claims qualifies as prior art.

Teodosiu 2002/0062375 is a published U.S. patent application that was filed on Sep. 13, 2001, after Appellants' priority date of Jan. 22, 2001. Teodosiu 2002/0062375 does claim the benefit of two provisional applications (60/252,658 and 60/252,659) both filed Nov. 22, 2000. However, the Nov. 22, 2000 filing date can only be used as Teodosiu's 35 U.S.C. § 103(a) prior art date for the subject matter that is common to both the published application and the provisional application(s). *See, In re Wertheim*, 209 USPQ 554 (CCPA 1981); *In re Giacomini*, 2010 WL 2674461 (Fed. Cir. 2010). Examination of Teodosiu's two provisional applications shows that they vary significantly from Teodosiu's published utility application.

It is well-established in case law that the Office has the burden of proof to produce the factual basis for the rejection. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968). The allocation of burdens requires that the USPTO produce the factual basis for its rejection of an application under 35 U.S.C. §§ 102 and 103. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967)). The one who bears the initial burden of presenting a *prima facie* case of unpatentability is the examiner. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Thus, to establish a *prima facie* case for the 35 U.S.C. § 103(a) rejection that relies on Teodosiu 2002/0062375, the Examiner must show where § 112 support resides in the earlier provisional application (60/252,658) for each instance of specific subject

matter relied upon in the published application (2002/0062375), including an explanation as to why the provisional (60/252,658) would still be recognized by the artisan as providing support for the subject matter from the cited reference (2002/0062375).

Appellants respectfully submit that, in finding that portions of Teodosiu 2002/0062375 relied upon by the Examiner in rejecting Appellants' claims qualify as prior art with respect to Appellants' claimed invention, the Board misapprehends or overlooks several facts of the case, as explained below. Contrary to the Board's ruling, the Examiner has not met the burden for establishing a *prima facie* case for the 35 U.S.C. § 103(a) rejection that relies on Teodosiu 2002/0062375.

a. The Board fails to establish that the portions of Teodosiu 2002/0062375 relied upon by the Board in the Findings of Facts are sufficiently supported in Teodosiu 60/252,658 to support the finding that the portions of Teodosiu 2002/0062375 relied upon in the rejection of Appellants' claims qualifies as prior art to the subject matter in Appellants' claims.

The Examiner has cited Teodosiu 2002/0062375, for example paragraphs [0030] and [0035]-[0037] in support of the assertion that Teodosiu teaches a peer computing system comprising: a plurality of peer nodes; wherein at least a subset of the peer nodes are configured to participate in a peer discovery protocol to discover other peer nodes, as recited in Appellants' claim 1.

In the Findings of Facts (Decision, pp. 4-5), to support the finding that Teodosiu's subject matter relied upon in the rejection qualifies as prior art, the Board appears to assert that finding (1) regarding Teodosiu 2002/0062375 is supported by finding (4) regarding Teodosiu 60/252,658, finding (2) regarding Teodosiu 2002/0062375 is supported by finding (5) regarding Teodosiu 60/252,658, and finding (3) regarding Teodosiu 2002/0062375 is supported by finding (6) regarding Teodosiu 60/252,658.

In finding (3), the Board asserts that in Teodosiu 2002/0062375 “peers locate peer resources through a two-step process. First, a peer seeking a particular resource communicates with its assigned home RNS server, which in turn determines one or more locations in the realm where the resource is available. Second, the peer accesses the resource at the provided location. The resource can be a resource published by another peer, in which case the step of accessing the resource involves a peer-to-peer request,” citing paragraphs [0037], [0073], and [0077]. In finding (6), the Board asserts that Teodosiu 60/252,658 discloses “a user request for a peer resource is communicated to the home RNS server. If the RNS server locates the resource, it returns information including a list of locations (IP addresses and ports) that can provide the resource. The requesting peer selects one or more locations from the list and directly connects to the location to effect transfer of the resource. The location information provided by the RNS server is the location of a publishing peer,” citing pages 6 and 7.

However, Teodosiu 2002/0062375, paragraph [0037], is not found in Teodosiu 60/252,658. Paragraph [0037] describes in detail accessing a resource in Teodosiu’s system as disclosed in Teodosiu’s published application. Teodosiu 60/252,658 only very broadly describes Teodosiu’s “platform” handling an attempt to access a peer resource at page 6, second and third paragraph. For example, the provisional application states “To resolve a location for the peer content, the Platform communicates with the Home RNS Server...If the RNS Server was able to locate the file, it returns two pieces of information to the requesting peer...”. In contrast, paragraph [0037] recites in part “The home RNS server 130, possibly in cooperation with registrar 110 and another RNS server 130, determines one or more locations within realm 150 where the resource is expected to be available. In one embodiment, the set of locations returned by the home RNS server 130 to the requesting peer 140 may depend on the current network identity (in particular, the current IP address or IP addresses) of peer 140, on the current traffic load on the realm, as well as on other parameters that are known to the RNS servers 130.” This subject matter as it appears in Teodosiu’s published application does not appear to be supported in Teodosiu’s provisional application, and certainly not in a way that provides written description of Appellants’ claimed invention.

Appellants also note that paragraph [0037] of Teodosiu 2002/0062375 discusses elements of Figure 1 in Teodosiu 2002/0062375. While on the surface similar to Figure 1 in Teodosiu 60/252,658, Figure 1 in Teodosiu 2002/0062375 includes significant differences from Figure 1 in Teodosiu 60/252,658. For example, neither Figure 1 nor Figure 2 of Teodosiu 60/252,658 shows a “registrar 110” as shown in Figure 1 of Teodosiu 2002/0062375.

In addition, Teodosiu 2002/0062375, paragraph [0073], is not found in Teodosiu 60/252,658. Page 5, fourth paragraph of Teodosiu’s provisional application briefly mentions that users can publish resources on their nodes by creating the files in a publication directory. However, paragraph [0073] of Teodosiu 2002/0062375 discloses that “In one embodiment, publishing can be accomplished by the user through an appropriate User Interface provided by platform 370 (not shown in FIG. 3). In one embodiment, publishing can be performed by peer-to-peer applications 345 by calling the appropriate function in the API 340 of platform 370.” This subject matter does not appear to be supported in Teodosiu’s provisional application, and certainly not in a way that provides written description of Appellants’ claimed invention..

Teodosiu 2002/0062375, paragraph [0077], is not found in Teodosiu 60/252,658. Teodosiu 60/252,658 only very broadly describes Teodosiu’s “platform” handling an attempt to access a peer resource at page 6, second and third paragraph. This section mentions that “the Platform acts as an HTTP proxy to the browser. Upon receipt of the URL, the platform applies the URL decision procedure and finds out if this is a peer URL; for a regular World Wide Web the platform would have acted as a pass-through.” Comparing the provisional application to paragraph [0077] of the published application, the subject matter as it appears in paragraph [0077] of Teodosiu’s published application does not appear to be supported in Teodosiu’s provisional application, and certainly not in a way that provides written description of Appellants’ claimed invention.. Moreover, paragraph [0077] describes elements of Figure 4 in Teodosiu’s published application; Figure 4 does not appear in Teodosiu’s provisional application.

Furthermore, Appellants' claim 1 does not recite (emphasis added): "peers locate peer resources through a two-step process. First, a peer seeking a particular resource communicates with its assigned home RNS server, which in turn determines one or more locations in the realm where the resource is available. Second, the peer accesses the resource at the provided location. The resource can be a resource published by another peer, in which case the step of accessing the resource involves a peer-to-peer request," as the Board finding (3) states is taught at paragraphs [0037], [0073], and [0077] of Teodosiu's published application. Instead, claim 1 recites "A peer computing system comprising: a plurality of peer nodes; wherein at least a subset of the peer nodes are configured to participate in a peer discovery protocol to discover other peer nodes." In contrast to teaching that a "resource" or "peer resource" that may be located using Teodosiu's RNS server include peer nodes, Teodosiu's actual teachings appear to preclude peer nodes from being "resources" that may be discovered using the RNS server. For example, at paragraph [0030], Teodosiu teaches "Peers 140 store, or otherwise make available, peer resources." Also see, e.g., paragraph [0040], which states:

As used herein, each resource is primarily associated with one peer, referred to as the master publisher, and may also be available at additional peers, referred to as the caching publishers. Usually, only a master publisher has the authority to publish, modify, or delete a resource.

A "peer node" would make no sense in the context of a "resource" or "peer resource" as disclosed by Teodosiu, for example in the above example citations. Thus, contrary to the Board's findings, Teodosiu cannot reasonably be said to teach peer nodes participating in a peer discovery protocol to discover other peer nodes, as recited in Appellants' claim 1.

Moreover, the Board's Findings of Fact regarding the Teodosiu reference in the Decision actually support Appellants' above argument. In finding (3), the Board asserts that in Teodosiu 2002/0062375 (emphasis added): "peers locate peer resources through a two-step process. First, a peer seeking a particular resource communicates

with its assigned home RNS server, which in turn determines one or more locations in the realm where the resource is available. Second, the peer accesses the resource at the provided location. The resource can be a resource published by another peer, in which case the step of accessing the resource involves a peer-to-peer request,” citing paragraphs [0037], [0073], and [0077]. In contrast, Appellants’ claim 1 recites “A peer computing system comprising: a plurality of peer nodes; wherein at least a subset of the peer nodes are configured to participate in a peer discovery protocol to discover other peer nodes.” Teodosiu 2002/0062375, in the cited paragraphs or elsewhere, does not teach or suggest that “peer resources” that are located by peers using the “two-step process” include other peer nodes. Instead, as noted above, Teodosiu’s actual teachings appear to preclude peer nodes from being “resources” that may be discovered using the RNS server.

Appellants further note the following:

In finding (1), the Board asserts that Teodosiu 2002/0062375 teaches “a system for locating and tracking resources in a peer-to-peer computer network, and that the peer-to-peer network, called a ‘realm,’ includes a number of peers 140, which make available peer resources, and Resource Naming Service (RNS) servers 130,” citing paragraphs [0029]-[0030]. In finding (4), the Board asserts that Teodosiu 60/252,658 discloses “a peer-to-peer locator and tracking service that comprises a number of user machines (“peers”) and one or more RNS servers,” citing page 3.

However, paragraphs [0029]-[0030] of Teodosiu 2002/0062375 do not appear on Teodosiu 60/252,658, page 3, and close inspection of paragraphs [0029]-[0030] of Teodosiu 2002/0062375 show that these paragraphs include significant differences from the subject matter disclosed on Teodosiu 60/252,658, page 3. For example, paragraph [0029] explicitly states that “RNS relies on a resource naming scheme that uniquely identifies peer resources no matter where among the peers the resources may be available” (emphasis added), which is not taught or suggested on page 3 of Teodosiu, 60/252,658.

In finding (2), the Board asserts that Teodosiu 2002/0062375 teaches “each RNS server tracks the current network location (IP address and IP port numbers) and status (on- or off-line) of all peers assigned to it as well as the locations and availability of resources among its assigned peers, citing paragraph [0035]. In finding (5), the Board asserts that Teodosiu 60/252,658 discloses “each RNS server stores the online status and current IP addresses and port numbers of the peer machines homed to that RNS server for use in pointing peers to other peers’ locations,” citing page 5.

However, paragraphs [0035] of Teodosiu 2002/0062375 does not appear on Teodosiu 60/252,658, page 3, and close inspection of paragraph [0035] of Teodosiu 2002/0062375 show that this paragraph varies significantly from the subject matter disclosed on Teodosiu 60/252,658, page 5. For example, paragraph [0035] states (emphasis added) “Each RNS server 130 tracks the current network location (in terms of IP addresses and IP port numbers)...of all peers assigned to that RNS server.” Page 5 of Teodosiu 60/252,658, on the other hand, states that “As part of the logon protocol, a peer informs its Home RNS server of its current IP address and port number.” A peer informing its Home RNS server of its current IP address and port number as part of a logon protocol is not the same as and does not provide support for the notion of an RNS server tracking the current network location of all peers assigned to that RNS server, as disclosed in Teodosiu 2002/0062375. In addition, paragraph [0035] states (emphasis added) “Each RNS server 130 tracks the ... status (on- or off-line) of all peers assigned to that RNS server.” Page 5 of Teodosiu 60/252,658, on the other hand, only states that “Each RNS Server keeps track of the current status of the peer machines that are homed to that server.” Page 5 of Teodosiu 60/252,658 does not provide support for the notion that the tracked status is “on- or off-line,” as disclosed in Teodosiu 2002/0062375

Appellants also note that paragraphs [0030] and [0035] of Teodosiu 2002/0062375 discuss elements of Figure 1 in Teodosiu 2002/0062375. While on the surface similar to Figure 1 in Teodosiu 60/252,658, Figure 1 in Teodosiu 2002/0062375 includes significant differences from Figure 1 in Teodosiu 60/252,658. For example,

neither Figure 1 nor Figure 2 of Teodosiu 60/252,658 shows a “registrar 110” as shown in Figure 1 of Teodosiu 2002/0062375.

b. The Board fails to establish that every portion of Teodosiu’s published application relied upon in the rejection the claims is found in both Teodosiu’s published application (the cited reference) and one of Teodosiu’s provisional applications (needed to establish a prior art date of the material).

In its decision, the Board finds that “pages 3-8 of Teodosiu 60/252,658 disclose the subject matter the Examiner relies on in Teodosiu 2002/0062375 for the 35 U.S.C. 103(a) rejection discussed below.” Decision at 6. As previously noted, it is well-established in case law that the Office has the burden of proof to produce the factual basis for the rejection. Appellants respectfully submit that the Board, in citing several pages of Teodosiu’s provisional application and alleging that these pages “teach the subject matter the Examiner relies on” in Teodosiu’s published application, fails to establish that every portion of Teodosiu’s published application relied upon by the Examiner in the rejection of Appellants’ claims is supported in Teodosiu’s provisional application.

For example, paragraphs [0016], [0030 - 0037], [0045], [0053], [0073], [0074], [0077], and [0094 - 0097] (relied upon by the Examiner) from Teodosiu’s published application are not found in the portion of Teodosiu’s provisional application number 60/252,685 (pages 3-8) cited by the Board. Some of these paragraphs (30, 35, 37, 73, and 77) were previously discussed. The following discusses several additional examples of paragraphs from Teodosiu’s published application that do not appear in Teodosiu’s provisional application.

Teodosiu 2002/0062375, paragraph [0016], is not found in Teodosiu 60/252,658, nor is the subject matter in this paragraph disclosed in 60/252,658. For example, the provisional application does not mention a need to “select a small set of ‘best’, or ‘closest’, copies for a given request” as recited in Teodosiu, paragraph [0016]. Nor does the provisional application mention that the ability to “select a small set of ‘best’, or

‘closest’, copies for a given request” requires tracking of all equivalent peer locations that have an up-to-date copy of and can serve the cached resource, as recited in Teodosiu, paragraph [0016].

Teodosiu 2002/0062375, paragraph [0031], is not found in Teodosiu 60/252,658. Moreover, paragraph [0031] specifically teaches (emphasis added): “As part of the registration process, registrar 110 assigns each peer an identifier that is unique within realm 150.” In contrast, page 4, section 3, first paragraph of the provisional application teaches (emphasis added): “To use our locator and tracking service, users must first choose a User Identifier (UID).” Furthermore, neither Figure 1 nor Figure 2 of Teodosiu 60/252,658 shows a “registrar 110,” and Teodosiu 60/252,658 does not disclose the notion of a “registrar” as disclosed in paragraph [0031]. Thus, paragraph [0031] of the published application differs significantly from the provisional application.

Teodosiu 2002/0062375, paragraph [0032], is not found in Teodosiu 60/252,658. Teodosiu 60/252,658 only very broadly states, at page 4, section 3, first paragraph, “To use our locator and tracking service, users must first chose [sic] a User Identifier (UID) and register with the User Database (UDB). This initial registration process can occur via the World Wide Web.” Paragraph [0032] of the published application, on the other hand, discloses “Any number of approaches can be used to register peers 140 with registrar 110. In one embodiment, peers 140 may use a Web-based registration process to obtain and register an identity with registrar 110. Registration may comprise a series of interactions between a peer 140 and registrar 110 to convey a user's identity, encryption keys for secure communications among elements within realm 150, billing information for access various peer resources, downloading and installing software to enable the peer 140 to be compatible with its assigned RNS server, and the like.” This subject matter is clearly not fully supported in Teodosiu's provisional application. For example, neither Figure 1 nor Figure 2 of Teodosiu 60/252,658 shows a “registrar 110,” and Teodosiu 60/252,658 does not disclose the notion of a “registrar” as disclosed in paragraph [0032].

Teodosiu 2002/0062375, paragraph [0034], is not found in Teodosiu 60/252,658, nor is the subject matter as recited in paragraph [0034] disclosed in 60/252,658. Paragraph [0034] describes registering new RNS servers; registering new RNS servers as disclosed in paragraph [0034] is not disclosed in, and thus is not supported by, Teodosiu's provisional application.

Appellants also note that paragraph [0030]-[0037] of Teodosiu's published application discuss elements of Figure 1 in Teodosiu's published application. While on the surface similar to Figure 1 in Teodosiu's provisional application, Figure 1 in Teodosiu's published application shows significant differences and changes from Figure 1 in the provisional application. For example, Figure 1 in the provisional application does not show a "registrar 110" as shown in Teodosiu's published application, nor does Figure 1 in the provisional application show a "realm 150" as shown in Teodosiu's published application

Teodosiu 2002/0062375, paragraph [0045], is not found in Teodosiu 60/252,658. Paragraph [0045] discloses an RNS server receiving a "resource request" from a peer or a gate server. Paragraph [0045] states that "the request uniquely identifies a resource and a master publisher of the resource within the realm to which this RNS server belongs." Appellants cannot find support in Teodosiu's provisional application for a request that "uniquely identifies a resource and a master publisher of the resource within the realm to which this RNS server belongs." Moreover, paragraph [0045] describes an element of Figure 2 in Teodosiu's published application; Figure 2 does not appear in Teodosiu's provisional application.

Teodosiu 2002/0062375, paragraph [0053], is not found in Teodosiu 60/252,658, nor can Appellants find support for the subject matter as taught in paragraph [0053] in Teodosiu's provisional application. Moreover, paragraph [0053] describes several elements of Figure 2 in Teodosiu's published application; Figure 2 does not appear in Teodosiu's provisional application.

Teodosiu 2002/0062375, paragraph [0074], is not found in Teodosiu 60/252,658, nor can Appellants find support for the subject matter as taught in paragraph [0074] in Teodosiu's provisional application.

Teodosiu 2002/0062375, paragraphs [0094]-[0097], do not appear in Teodosiu 60/252,658. These paragraphs are in a section titled "Dynamic Peer-to-peer Realm Identification." This section does not appear in Teodosiu's provisional application, nor can Appellants find any mention of "Dynamic Peer-to-peer Realm Identification" or support for the subject matter of this section in the provisional application. Moreover, paragraphs [0095]-[0097] describe elements of Figure 6 in Teodosiu's published application; Figure 6 does not appear in Teodosiu's provisional application.

Appellants maintain that the rejection of claim 1 is improper because the Examiner has not shown that the portions of Teodosiu 2002/0062375 relied upon by the Examiner in the rejection of Appellants' claims qualifies as a prior art reference. As shown above, many portions of Teodosiu's published application relied upon by the Examiner in the rejection of Appellants' claims do not appear to be supported by Teodosiu's provisional application. The Nov. 22, 2000 filing date can only be used as Teodosiu's 35 U.S.C. § 103(a) prior art date for subject matter that is common to both the published application and the provisional application. The Office has the burden of proof to produce the factual basis for the rejection. Since the Office has not met this burden of proof, the rejection is improper.

For the foregoing reasons, it is submitted that the Board's finding that "pages 3-8 of Teodosiu 60/252,658 disclose the subject matter the Examiner relies on in Teodosiu 2002/0062375 for the 35 U.S.C. 103(a) rejection discussed below" is unsupported by the facts and is contrary to Federal Circuit precedent.

c. The Board's finding that the portions of Teodosiu's published application relied upon by the Examiner in the rejection of Appellants' claims qualify as prior art fails to demonstrate that Teodosiu's provisional applications satisfies the written

description requirement for at least one claim found in Teodosiu's published application.

Under 35 U.S.C. 119(e)(1), a published utility application is not entitled to its provisional application's filing date as a prior art date unless at least one claim of the published utility application is supported (per 35 U.S.C. § 112) in the provisional application. Since both of Teodosiu's provisional applications are much shorter informal papers as compared to Teodosiu's utility application, it is not at all clear that either one of Teodosiu's provisional applications provide full 35 U.S.C. § 112 support for any of the claims of Teodosiu's published utility application. The rejection is improper unless the Office can show that Teodosiu's published application has the necessary claim support in the provisional application to be entitled to the provisional application's filing date as its § 103(a) prior art date. Furthermore, the Examiner has the burden of proof to produce the factual basis for the rejection. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968).

In its decision, the Board finds that "page 6 of Teodosiu 60/252,658 does support claim 1 of Teodosiu 2002/0062375...Specifically, Teodosiu 60/252,658 provides support for 'receiving a peer resource request...', 'generating a peer resource response...', and 'returning the peer resource response...', as recited in claim 1 of Teodosiu 60/252,658." Decision at 6-7. Appellants respectfully submit that, contrary to the Board's findings, it is not at all clear that Teodosiu's provisional application satisfies the written description requirement for the embodiment as recited in claim 1 of Teodosiu's published application. As explained below, contrary to the Board's findings, the limitations as recited in claim 1 of Teodosiu's published application differ significantly from the subject matter as disclosed on page 6 of Teodosiu's provisional application, and thus do not appear to satisfy the written description requirement.

Teodosiu's claim 1 recites "receiving a peer resource request at a resource naming service (RNS) server, said peer resource request being received from a peer platform through a networking environment." In contrast to this limitation, page 6, second

paragraph of Teodosiu's provisional application recites "when a user or a peer-to-peer application tries to access a peer resource, the request is intercepted by the Platform...the platform applies the URL decision procedure and finds out that this is a peer URL...To resolve a location for the peer content, the Platform communicates with the Home RNS Server." Thus, while claim 1 recites that a "peer resource request" is received at an RNS server from a peer platform through a "networking environment," Teodosiu's provisional application recites that a "user or a peer-to-peer application" tries to access a peer resource, which is intercepted by a "Platform", which applies a URL decision procedure to "find out that this is a peer URL", and which then "communicates with the Home RNS server" to resolve a location for the peer content. This portion of Teodosiu's provisional application does not provide clear support for the notion of a "peer resource request" that is received at an RNS server from a peer platform as recited in claim 1 of Teodosiu's published application. Instead, it describes that a "Platform" intercepts an access by a peer-to-peer platform; the "Platform" then communicates with the RNS server to resolve a location for the peer content.

Teodosiu's claim 1 further recites "generating a peer resource response based on the peer resource request." Page 6, second paragraph of Teodosiu's provisional application does not teach the limitations as they appear in Teodosiu's claim 1. Instead, the citation simply states "If the RNS Server was able to locate the file, it returns two pieces of information to the requesting peer." The cited portion of Teodosiu's provisional application does not provide clear support for the notion of "generating a peer resource response" as recited in claim 1 of Teodosiu's published application.

Teodosiu's claim 1 further recites "returning the peer resource response to the peer platform through the networking environment, said peer resource response to enable the peer platform to access a peer resource corresponding to the peer resource request within the networking environment." Again, page 6, second paragraph of Teodosiu's provisional application does not provide clear support for these limitations as they appear in Teodosiu's claim 1. Instead, the citation simply states "If the RNS Server was able to locate the file, it returns two pieces of information to the requesting peer: * The current

version of the file. * A list of (IP Address, port) pairs of locations that can serve the requested content.”

Applicants respectfully contend that, contrary to the Board’s finding, it is not at all clear that page 6 of Teodosiu’s provisional application provides full and clear 35 U.S.C. § 112 support for claim 1 of Teodosiu’s published utility application, as pointed out above. The rejection is improper unless the Office can show that Teodosiu’s published application has the necessary claim support in the provisional application to be entitled to the provisional application’s filing date as its § 103(a) prior art date. Furthermore, the Office has the burden of proof to produce the factual basis for the rejection. Applicants respectfully assert that the Examiner has not satisfied this burden of proof.

d. The Board’s finding that “Teodosiu 2002/0062375 qualifies as prior art with respect to Appellants’ claimed invention” on page 7 of the Decision is counter to a previous Board Decision in a case similar to the present application.

Appellants refer to the non-precedential Decision on Appeal (Appeal 2007-2225, Application 10/054,809, Technology Center 2100, Decided August 31, 2007). In that case, the same Teodosiu reference was used in rejecting Patent Application 10/054,809, which has the same filing date and priority date (January 22, 2002 and Jan. 22, 2001, respectively) as the instant application. From the Decision (emphasis added):

The allocation of burdens requires that the USPTO produce the factual basis for its rejection of an application under 35 U.S.C. §§ 102 and 103. *In re Piatecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967)). The one who bears the initial burden of presenting a prima facie case of unpatentability is the examiner. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)

...In accordance with the Examiner’s theory that some or all of the Teodosiu published application may be applied against the instant claims, the rejection should show, to establish a prima facie case for unpatentability, where § 112 support resides in the earlier provisional applications for each instance of specific subject matter relied upon in the

published applications, including an explanation why the provisionals would still be recognized by the artisan as providing support if not “word for word” the same as the later text or drawings. Mere reference to the text or drawings of Teodosiu is not sufficient. The Teodosiu published application, by itself, shows no more than the material published from the application that was filed in the USPTO on September 13, 2001, which, according to this record, is later than the effective filing date of each of the claims rejected. (emphasis added)

For at least the same reasons stated by the Board in the Decision on Appeal in Application 10/054,809, Appellants assert that the Examiner has failed to establish that the portions of Teodosiu’s published application relied upon by the Examiner in the § 103 rejection of Appellants’ claims have not been established to be prior art to the present application.

For the foregoing reasons, it is submitted that the Board’s finding that “Teodosiu 2002/0062375 qualifies as prior art with respect to Appellants’ claimed invention” on page 7 of the Decision is contrary to both the facts of this case, and is inconsistent with a previous Board decision on the same issue.

2. The Board’s position that Teodosiu teaches the claims limitation *wherein at least a subset of the peer nodes are configured to participate in a peer discovery protocol to discover other peer nodes* misapprehends the Teodosiu reference’s teachings and overlooks the entirety of Appellants’ actual argument.

On pages 7-8 of the Decision, the Board agrees with the Examiner’s findings that Teodosiu 2002/0062375 teaches peers registering to participate in a peer-to-peer realm, and each peer communicating with its home RNS server to discover resources, and finds that “This teaching meets claim 1’s limitation of ‘wherein at least a subset of the peer nodes are configured to participate in a peer discovery protocol to discover other peer nodes’.” The Board goes on to find that “Teodosiu’s 2002/0062375 teaching of each peer communicating with its RNS server to discover peer resources meets the limitation of peer nodes that ‘participate in a peer discovery protocol’ as claimed.”

Appellants contend that the Board is misapprehending Teodosiu's teachings, as Teodosiu's teachings of "peers registering to participate in a peer-to-peer realm, and each peer communicating with its home RNS server to discover resources" does not teach or even suggest the notion of peer nodes participating in a peer discovery protocol to discover other peer nodes, as recited in claim 1. Teodosiu is directed to a "locator and tracking service" that includes an RNS server for locating "peer resources." Appellants can find no teaching or suggestion in Teodosiu that these "resources" that may be located using the RNS server include peer nodes. See, e.g., Appeal Brief, page 18, lines 4-6, and Reply Brief, page 9, lines 2-3. The Board's ruling as noted above appears to overlook this important portion of Appellants' argument.

In contrast to teaching that a "resource" or "peer resource" that may be located using Teodosiu's RNS server include peer nodes, Teodosiu's actual teachings appear to preclude peer nodes from being "resources" that may be discovered using the RNS server. For example, at paragraph [0030], Teodosiu teaches "Peers 140 store, or otherwise make available, peer resources." Also see, e.g., paragraph [0040], which states:

As used herein, each resource is primarily associated with one peer, referred to as the master publisher, and may also be available at additional peers, referred to as the caching publishers. Usually, only a master publisher has the authority to publish, modify, or delete a resource.

A "peer node" would make no sense in the context of a "resource" or "peer resource" as disclosed by Teodosiu, for example in the above example citations. Thus, contrary to the Board's findings, Teodosiu cannot reasonably be said to teach peer nodes participating in a peer discovery protocol to discover other peer nodes, as recited in Appellants' claim 1.

Moreover, the Board's Findings of Fact regarding the Teodosiu reference in the Decision actually support Appellants' above arguments. In finding (3), the Board asserts that in Teodosiu 2002/0062375 (emphasis added): "peers locate peer resources through a two-step process. First, a peer seeking a particular resource communicates

with its assigned home RNS server, which in turn determines one or more locations in the realm where the resource is available. Second, the peer accesses the resource at the provided location. The resource can be a resource published by another peer, in which case the step of accessing the resource involves a peer-to-peer request,” citing paragraphs [0037], [0073], and [0077].

For at least the foregoing reasons, it is submitted that the Board’s decision affirming the rejection of claims 1, 2, 10, and 18 as obvious over the combination of Tcodosiu and Badovinatz is unsupported by the facts of the case.

CONCLUSION

For the foregoing reasons, Appellants respectfully request that the Board reconsider its decision on appeal for the present application and reverse the Examiner's rejection.

The Commissioner is authorized to charge any fees that may be due to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5181-82104/RCK.

Respectfully submitted,

/Robert C. Kowert/
Robert C. Kowert, Reg. #39,255
Attorney for Appellants

Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.
P.O. Box 398
Austin, TX 78767-0398
(512) 853-8850

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